

#13
11/11/10

Attorney Docket: 4400/8000-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:

Yoshihiro Suzuki et al.

Confirmation No.: 3652

Patent No.: 6,561,716

Art Unit: 3671

Filed: June 1, 2000

Examiner: Robert Pezzuto

For: UNIVERSAL JOINT DEVICE AND METHOD
OF MANUFACTURING THE DEVICE

Issued Date: May 13, 2003

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF
MAINTENANCE FEES IN EXPIRED PATENT**

MS Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This is a petition to accept payment of maintenance fees for U.S. Patent No. 6,561,716 ("the '716 patent") after expiration of the patent, wherein the delay in payment of the maintenance fees was unavoidable. *See* 37 CFR §1.378(b). The required maintenance fee owed under 37 CFR §§1.20(e)-(f) (\$980) and the surcharge owed under 37 CFR §1.20(i)(1) (\$700) are submitted concurrently herewith by authorization to deduct these amounts from Deposit Account No. 50-4570. As shown below, all of which is based upon information and belief, the delayed payment was unavoidable since reasonable care was taken to ensure that the maintenance fees would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

**Steps Taken To Ensure Timely Payment
Of The Maintenance Fee**

The '716 patent issued on May 13, 2003 and the first maintenance fee for this patent could have been paid during the period from May 13, 2006 to November 13, 2006. The fee also

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could have been paid with a surcharge during the period from November 13, 2006 through May 13, 2007. The fee was not paid and accordingly, the patent expired after midnight on May 13, 2007

The assignee of the patent is Kabushiki Kaisha Somic Ishikawa of Tokyo Japan ("Somic Ishikawa"). Its patent affairs are handled in Japan by Kabasawa & Associates of Tokyo Japan ("Kabasawa"). Kabasawa engaged the firm of Darby & Darby ("Darby") to prosecute the patent application which led to the patent in the United States and to be responsible for paying maintenance fees in the U.S.

As of 2005 Darby had been in business as an intellectual property firm with a significant U.S. Patent prosecution practice for 110 years. It had a separate department of the firm which handled maintenance and annuity fees. The department had an experienced manager and from four to five paralegals. It also had well established and time-tested procedures for assuring that maintenance fees were timely paid. It included a docketing system that would notify the maintenance and annuity fee paralegals as well as the working, supervising and billing attorneys if a due date was approaching.

As of March 31, 2010, Darby ceased the practice of law. As a result it has been difficult getting information and documentation for this petition.

Near the end of 2005 Darby sent to Kabasawa a list of patents in which annuities were due in the 4th Quarter of 2006. The '716 patent was on the list.

By May 21, 2006 Kabasawa had returned the list to Darby with an indication that the maintenance fee for the '716 patent should be paid. A copy of the list is attached as **Exhibit A**.

One of the paralegals, Perry Moy, was assigned to handle the payment. Mr. Moy was well trained in the procedures that had been established and had paid numerous maintenance fees in the past without incident. He followed the existing procedures to a point. In particular, he updated the docketing system to indicate that the payment had been made. Attached as **Exhibit B** is a printout of the docket for this patent indicating that the first maintenance fee was paid on

July 27, 2006. He also notified accounting of the payment. As a result, an invoice was issued to Kabasawa for payment of the fee. A copy of the invoice for the fee dated August 31, 2006 is attached as **Exhibit C**. The one critical thing that Mr. Moy forgot to do was to notify MDC, the maintenance fee company used by Darby, that they should effect payment of the fee.

Thus, as of August 31, 2006, everyone at Darby assumed the fee had been paid as reflected by the updated docket system. Kabasawa and Somic Ishikawa assumed it had been paid because that was their instruction and they were billed for the service.

With Darby no longer being in business and the second maintenance fee coming due on May 13, 2010, Kabasawa began to look into alternative ways of getting the fee paid. In October 2010, Kabasawa checked public PAIR and learned for the first time that the patent had expired in 2007 for non-payment of the first maintenance fee. However, Kabasawa no longer had a contact at Darby whom they could question about the situation.

Eventually on October 20, 2010, Kabasawa contacted the Dissolution Committee of Darby to inquire as to what happened. A copy of an e-mail to the Dissolution Committee is attached as **Exhibit D**. The undersigned is a member of the Dissolution Committee.

After an investigation that was as complete as possible, considering that Darby has only a small staff for collecting accounts receivables, and not part of the former maintenance fee department, the undersigned agreed to submit this petition.

**Legal Principals That Support Acceptance of This
Late Payment of Maintenance Fee**

Under 35 U.S.C. § 41(b), the Director may accept late payment of a maintenance fee if the delay in payment is shown to have been "unavoidable." To satisfy the "unavoidable" standard, "one must show that he exercised the due care of a reasonably prudent person," *Ray v. Lehman*, 55 F.3d 606, 609 (Fed. Cir. 1995). This legal standard was also addressed in *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. App. 1912), which explains the meaning of the word "unavoidable" in the context of delayed maintenance fee payments as follows:

It is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them, in the exercise of this care, to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all the other conditions of good faith and promptness in its ratification being present.

To paraphrase, if a patentee relies upon "the ordinary and trustworthy agencies of mail," "worthy and reliable employees," and "other means and instrumentalities" that are usually employed by "prudent and careful men in relation to their most important business," and a failure occurs "unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities," such failure may be said to have been "unavoidable" if all other "conditions of good faith and promptness" are present.

Here the assignee Somic Ishikawa and its agent Kabasawa relied in good faith upon these types of trustworthy and reliable means and instrumentalities. In particular, they provided clear instructions to Darby, a firm in business for 110 years, and a firm they could reasonably consider trustworthy and reliable. Further they received confirmation that their instructions to pay the fee had been carried out.

Darby had in place procedures for payment of maintenance fees and a staff dedicated to that process. However, a single human error caused a failure to pay the fee and disabled the backup features. If Mr. Moy had merely forgotten to pay the fee, docket notices would have warned the attorneys assigned to the case and the manager of the department that the fee was not paid. If he had not notified accounting that the fee was paid, the billing attorney may have noticed and outstanding fee. Thus, the error cause harm not because of a human mistake in failing to notify MDC to pay the fee, but in completing the rest of the procedure.

Payment of the Second Maintenance Fee

The deadline for paying the second maintenance fee is November 13, 2010, without surcharge, and amounts to (\$2480). The office is authorized to deduct this amount from Deposit Account No. 50-4570.

Conclusion

Given the foregoing, the patentee hereby respectfully submits that the entire delay in paying the first (fourth year) maintenance fee for the '716 patent was unavoidable because it resulted from a single human error by a trusted employee of a firm in which the patentee could reasonably have trusted. Also, the failure to notice that the fee had not been paid was unavoidable because of the indications provided to the patentee that the fee had been paid. Accordingly, the patentee respectfully requests that this petition be granted, allowing the delayed payment of the fourth year maintenance fee to be accepted, and for the '716 patent to be reinstated.

Since the window for paying the eighth year maintenance fee without surcharge for the '716 patent closes on November 13, 2010, this Petition is being submitted concurrently with a payment of the second (eighth year) maintenance fee owed under 37 CFR §§1.20(e)-(f) for this patent.

If the U.S. Patent and Trademark Office determines that any additional fees are required, the Commissioner is hereby authorized and requested to charge any deficiency owed, and/or credit any refund due, to Deposit Account No. 50-4570.

Dated: November 11, 2010

Respectfully submitted,


By 
Melvin C. Garner
Registration No.: 26,272
LEASON ELLIS LLP
81 Main Street
White Plains, New York 10601
(914) 821-8005
(914) 288-0023 (Fax)
Attorneys/Agents For Patentee

EXHIBIT A

Return to: Polly Stevens
Fax: (212) 527-7701
Number of Pages: _____

Darby & Darby, PC Annuity Payment Authorization List/Worksheet

Annuities Due 4th Quarter 2006

Client Number: 09450 - Kabasawa & Associates

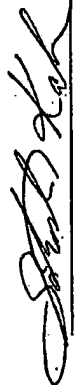
United States	Yoshihiro SUZUKI	6,561,716	09/12/219	11/13/2006	\$ 1212	<input checked="" type="checkbox"/> Pay
Title: UNIVERSAL JOINT DEVICE AND METHOD OF MANUFACTURING THE DEVICE				Tax Year: 4	Entity: Large	<input type="checkbox"/> Do not pay
Our Ref: 000K683-US0					<input type="checkbox"/> Entity Status Has Changed	<input type="checkbox"/> Darby & Darby, PC
ClientRefNo: F501003PUS						<input type="checkbox"/> Not Responsible

Return to: Polly Stevens
Fax: (212) 527-7701
Number of Pages: _____

Darby & Darby, PC Annuity Payment Authorization List/Worksheet
Annuities Due 4th Quarter 2006
Client Number: 09450 - Kabasawa & Associates

United States	Hidato FURUTA	6,560,495	09/513,363	11/6/2006	\$ 1212	Entity: Large	Entity Status Has Changed	Pay	Do not pay	Darby & Darby, PC	Not Responsible
Title: METHOD AND DEVICE FOR LOCKING WORK MACHINE								<input type="checkbox"/>	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>
Our Ref: 000K669-US0											
ClientRefNo: P0004US											
JUL 26, 2006											
United States	Yoshihiro SUZUKI	6,561,716	09/762,319	11/13/2006	\$ 1212	Entity: Large	Entity Status Has Changed	Pay	Do not pay	Darby & Darby, PC	Not Responsible
Title: UNIVERSAL JOINT DEVICE AND METHOD OF MANUFACTURING THE DEVICE								<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
Our Ref: 000K683-US0											
ClientRefNo: FB01003PUS											
JUL 26, 2006											
United States	Mitsuru FUKUSHIMA	5,424,793	08/223,701	12/13/2006	\$ 4112	Entity: Large	Entity Status Has Changed	Pay	Do not pay	Darby & Darby, PC	Not Responsible
Title: ZOOM LENS CAMERA VIEWFINDER								<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
Our Ref: 100K698-US1											
ClientRefNo: P9411US											
JUN 26, 2006											
United States	Toshiyuki HANADA	5,420,560	08/135,064	11/30/2006	\$ 2212	Entity: Small	Entity Status Has Changed	Pay	Do not pay	Darby & Darby, PC	Not Responsible
Title: FUSE								<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
Our Ref: 100K707-US1											
ClientRefNo: P9227US											
JUL 26, 2006											
Total Tax:										\$	8,748

4 Records for: 09450



Satoshi KABASAWA
KABASAWA & ASSOCIATES

EXHIBIT B

EXHIBIT C

IN ACCOUNT WITH

**DARBY &
DARBY**

PROFESSIONAL
CORPORATION

INTELLECTUAL PROPERTY LAW

NEW YORK

805 THIRD AVENUE
NEW YORK, NY 10022
TEL: 212.527.7700
FAX: 212.527.7701

SEATTLE

1191 SECOND AVENUE
SEATTLE, WA 98101
TEL: 206.262.8900
FAX: 206.262.8901

FEDERAL ID NO. 13-2766173

Invoice Date: August 31, 2006

Invoice No.: 691994

Kabasawa & Associates
The NSO Building
1-22, Shinjuku, 3-Chome
Shinjuku-Ku, Tokyo 160, Japan

Client No: 09450

For Professional Services Rendered Through August 31, 2006, in Connection with the Following Matter:

9509450-000

MAINTENANCE FEES/RENEWALS

Costs Advanced

08/31/06	Maintenance Fees/Renewals	1,212.00
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Total Costs Advanced	\$ 1,212.00
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Invoice Total	\$ 1,212.00
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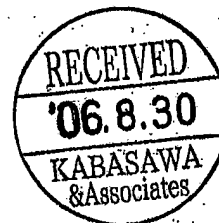


EXHIBIT D

Melvin C. Garner

From: OKITA [okita@kabasawa.com]
Sent: Wednesday, October 20, 2010 1:37 AM
To: agogoris@merchantgould.com; ludwig@fr.com; Melvin C. Garner
Cc: KABASAWA satoshi; KABASAWA & Associates
Subject: Status of the maintenance fee payment for U.S. Patent No. 6,561,716 (Darby's Ref.: 9450/0K683US0, Our Ref.: FB01003PUS)
Attachments: Invoice and Acknowledgement.pdf; Our instructions.pdf
Importance: High

Dear Sirs,

With respect to the above-mentioned U.S. Patent No. 6,561,716 (Darby's Ref.: 9450/0K683US0, Our Ref.: FB01003PUS), we noticed that it has already expired in 2007 due to non-payment of maintenance fees.

We are very surprised because we have already instructed Darby & Darby to proceed with payment of the maintenance fee, and have transferred payment soon after that. We didn't know the patent has already expired until recently, as we haven't received any notices informing us of the expiration of the patent (i.e. a Notice of Patent Expiration) from Darby & Darby.

For your information, we enclosed herewith the invoice and acknowledgement of our instructions for this case as the file attachments.

Please explain why the maintenance fee was not paid in spite of our instructions. At the same time, since our client consider this right to be important, please let us know if we can revive this patent or not.

Looking forward to hearing from you.

Yours sincerely,

Chika OKITA (Ms.)
for Satoshi KABASAWA

=====

KABASAWA & ASSOCIATES
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Electronic Acknowledgement Receipt

EFS ID:	8816539
Application Number:	09762319
International Application Number:	
Confirmation Number:	3652
Title of Invention:	UNIVERSAL JOINT DEVICE AND METHOD OF MANUFACTURING THE DEVICE
First Named Inventor/Applicant Name:	Yoshihiro Suzuki
Customer Number:	07278
Filer:	Melvin C. Garner/Alma D. Clemena
Filer Authorized By:	Melvin C. Garner
Attorney Docket Number:	M1596-232
Receipt Date:	11-NOV-2010
Filing Date:	06-FEB-2001
Time Stamp:	12:46:54
Application Type:	U.S. National Stage under 35 USC 371

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		PetUnavoidDelayedPymntMain tenancefees.pdf	994861 85bbbd4127287bc53df10225e71ace61423 780fb	yes	15

	Multipart Description/PDF files in .zip description		
	Document Description	Start	End
	Miscellaneous Incoming Letter	1	1
	Petition for review by the Office of Petitions.	2	15

Warnings:

Information:

2		POA_STATEMENT.pdf	153483	yes	2
			660a10ff9eee85babf77a334f5ca5a60ea0b305		

	Multipart Description/PDF files in .zip description		
	Document Description	Start	End
	Power of Attorney	1	1
	Assignee showing of ownership per 37 CFR 3.73(b).	2	2

Warnings:

Information:

Total Files Size (in bytes):		1148344
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Docket No.: 4400/8000-001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: _____ 0
Yoshihiro Suzuki et al.

Patent No.: 6,561,716 Issued: May 13, 2003

Confirmation No.: 3652

Application No.: 09/762,319 Filed: February 6, 2001

Art Unit: 3671

For: UNIVERSAL JOINT DEVICE AND METHOD OF
MANUFACTURING DEVICE

Examiner: Robert Pezzuto

AUTHORIZATION TO CHARGE OUR DEPOSIT ACCOUNT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Commissioner is hereby authorized to charge the required fees below and any deficiency owed to Deposit Account No. 50-4570.

1. \$700 – 37 C.F.R.1.20(i)(1) Surcharge after expiration – Late payment is unavoidable;
2. \$980 – 37 CFR 1.20(e)-(f) Maintenance Fee owed;
3. \$2480 – Payment of the Second Maintenance fee.

Dated: November 11, 2010

Respectfully submitted,

By 

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